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EXAMINER
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WINTER, JOHN M

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 12/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/639,014

Applicant(s)

GALLAGHER ET AL.

Examiner

John M Winter

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on September 9, 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) 8,9,17-19,34 and 36-42 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 43-48 is/are allowed.
- 6) ☒ Claim(s) 1- 7, 11-16, 20-33, and 35 is/are rejected.
- 7) ☒ Claim(s) 10 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

Art Unit: 3621

## DETAILED ACTION

### Status

Claims 1-7, 10-16, 20-33, 35 and 43-48 are pending.

Claims 8,9,17-19,34 and 36-42 are canceled.

### *Response to Arguments*

The Applicants arguments filed on September 9, 2003 have been fully considered.

The amended claims are rejected in view of the newly discovered reference Brake Jr. et al. (US Patent 6,032,136). See following rejection.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 6, 7, 11-16, 20-25 and 28-33 are rejected under 35 U.S.C. 103(a) as being anticipated by Ito et al. (US Patent 6,039,250) in view of Amos (US Patent 6,554,184) and further in view of Brake Jr. et al. (US Patent 6,032,136).

As per claim 1,

Ito et al. ('250) discloses a computer implemented method of transferring funds from one online account to another, the method comprising the steps of

automatically sending an electronic message to the recipient using the electronic message address, the electronic message indicating that funds are ready for transfer to the recipient;(Abstract)

receiving a response from the recipient accepting or rejecting the transfer of funds;(Figure 4)

transferring said amount of funds from the first account to a second account associated with the recipient if the response indicates acceptance.(Figure 2)

Ito et al. ('250) does not explicitly disclose "receiving a transfer request from a first user, the transfer request including an amount of funds for transfer from a first online account associated with the first user and identification information for a recipient of the funds". Amos ('184) discloses "receiving a transfer request from a first user, the transfer request including an amount of funds for transfer from a first online account associated with the first user and identification information for a recipient of the funds", (column 2, lines 44-52, also figure 2). It would be obvious to one of ordinary skill in the art at the time of the invention to combine the Ito

Art Unit: 3621

et al method with Amos's teaching in order to allow the completion of a financial transaction while providing the convenience to the consumer of completing the transaction at a time outside normal banking hours via the Internet.

Ito et al discloses ...the identification information including an electronic message address for the recipient;(Abstract)

Ito et al. ('250) does not explicitly disclose "opening a first online account in response to a request from a first user to open the first account, receiving credit card account information from the first user, establishing a connection with a server associated with the credit card account, transferring funds from the credit card account to the first account ". Brake, Jr et al. ('136) discloses "opening a first online account in response to a request from a first user to open the first account (Column 2, lines 51-58), receiving credit card account information from the first user,(Column 6, lines 5-26) establishing a connection with a server associated with the credit card account,(Column 6, lines 5-26) transferring funds from the credit card account to the first account (column 10, lines 11-18)". It would be obvious to one of ordinary skill in the art at the time of the invention to combine the Ito et al method with Brake, Jr et al. teaching in order to allow the consumer to manage credit accounts.

As per claim 2,  
Ito et al. ('250) discloses the method of claim 1,  
wherein the electronic message address is an e-mail address, and wherein the electronic message is an e-mail message.(Abstract)

Claims 13, 24 and 31 are in parallel with claim 2 and are rejected for the same reasons

As per claim 3,  
Ito et al. ('250) discloses the method of claim 1,  
Official Notice is taken that "the electronic message address includes a user ID associated with the recipient, and wherein the step of automatically sending an electronic message includes initiating an instant message session with the recipient based on the user ID" is common and well known in prior art in reference to electronic commerce. It would have been obvious to one having ordinary skill in the art at the time the invention was made that the electronic message address includes a user ID associated with the recipient, and wherein the step of automatically sending an electronic message includes initiating an instant message session with the recipient based on the user ID because instant messaging services are an inexpensive form of communication which would serve to reduce the overhead of the systems operation.

Claims 14, 25 and 32 are in parallel with claim 3 and are rejected for the same reasons

As per claim 6,  
Ito et al. ('250) discloses the method of claim 1, wherein the transfer request further includes a request for identity confirmation, and wherein the response from the recipient includes identity information responsive to the request for identity confirmation, the method further including the steps of :  
automatically sending the identity information to the first user;(Column 5, lines 27-40).

Art Unit: 3621

receiving from the first user an acceptance or a rejection of the identity information;(Column 5, lines 41-46, also figure 2)  
wherein funds are transferred only if an acceptance is received from the first user.(Figure 4)

As per claim 7,  
Ito et al. ('250) discloses the method of claim 6,  
wherein the request for identity confirmation includes a query, and wherein the identity information from the recipient includes an answer to the query.(Column 5, lines 16-39)

As per claim 11,  
Ito et al. ('250) discloses the method of claim 1  
Official Notice is taken that "method is implemented in a host server, and wherein the electronic message includes a URL link to the host server" is common and well known in prior art in reference to electronic commerce. It would have been obvious to one having ordinary skill in the art at the time the invention was made to implement the method in a host server, wherein the electronic message includes a URL link to the host server because this would allow access to the server via Internet.

As per claim 12,  
Ito et al. ('250) discloses a computer implemented method of transferring funds from one online account to another, the method comprising the steps of.  
automatically sending an electronic message to the payor using the electronic message address, the electronic message including the amount of funds to be transferred to the first user;(Abstract)  
receiving a payment response from the payor indicating acceptance or rejection of the payment request;(Figure 4)  
sending a second electronic message to the first user indicating whether the payment response from the recipient indicates acceptance or rejection of the payment request; and if the payment response indicates acceptance:  
receiving a transfer request from the first user indicating that the funds be transferred to an identified online account associated with the first user; and  
transferring funds to the identified online account from a second account associated with the payor in response to the transfer request.(Figure 2)

Ito et al. ('250) does not explicitly disclose "receiving a payment request from a first user, the payment request including an amount of funds for transfer to an online account associated with the first user and identification information for a recipient of the payment request (payor)". Amos ('184) discloses "receiving a payment request from a first user, the payment request including an amount of funds for transfer to an online account associated with the first user and identification information for a recipient of the payment request (payor)", (column 2, lines 44-52, also figure 2). It would be obvious to one of ordinary skill in the art at the time of the invention to combine the Ito et al method with Amos's teaching in order to allow the completion of a financial transaction while providing the convenience to the consumer of completing the transaction at a time outside normal banking hours via the Internet.

Art Unit: 3621

Ito et al discloses ... the identification information including an electronic message address of the payor;(Abstract)

Ito et al. ('250) does not explicitly disclose "Wherein the payment response further includes a request to open an account for the payor, the method further including: opening the second account, depositing funds into the second account wherein depositing includes receiving credit card account information from the payor, establishing a connection with a server associated with the credit card account and transferring funds from the credit card account to the second account". Brake, Jr et al. ('136) discloses "Wherein the payment response further includes a request to open an account for the payor, the method further including: opening the second account,(Column 2, lines 51-58) depositing funds into the second account wherein depositing includes receiving credit card account information from the payor,(Column 6, lines 5-26) establishing a connection with a server associated with the credit card account (Column 6, lines 5-26) and transferring funds from the credit card account to the second account(column 10, lines 11-18)". It would be obvious to one of ordinary skill in the art at the time of the invention to combine the Ito et al method with Brake, Jr et al. teaching in order to allow the consumer to manage credit accounts.

As per claim 15,

Ito et al. ('250) discloses the method of claim 12, wherein if the payment response from the payor indicates acceptance of the payment request, the payment response further includes a request for identity confirmation, and wherein the transfer request from the first user includes identity information responsive to the request for identity confirmation, the method further including the steps of

automatically sending the identity information to the payor;(Column 5, lines 27-40)

receiving from the payor an acceptance or a rejection of the identity information;(Column 5, lines 41-46, also figure 2)

wherein funds are transferred only if an acceptance of the identity information is received from the payor.(Figure 4)

As per claim 16,

Ito et al. ('250) discloses the method of claim 12

further including the step of transferring funds from the identified online account to a user identified credit card account in response to a request from the first user to withdraw funds from the identified online account.(Abstract)

As per claim 20,

Ito et al. ('250) discloses the method of claim 12

Official Notice is taken that "method is implemented in a host server, and wherein the electronic message includes a URL link to the host server" is common and well known in prior art in reference to electronic commerce. It would have been obvious to one having ordinary skill in the art at the time the invention was made to implement the method in a host server, wherein the electronic message includes a URL link to the host server because this would allow access to the server via Internet.

Art Unit: 3621

As per claim 21,

Ito et al. ('250) discloses the method of claim 12,

Official Notice is taken that "a plurality of online accounts are associated with the first user, and wherein the identified account is one of the plurality of online accounts" is common and well known in prior art in reference to electronic commerce. It would have been obvious to one having ordinary skill in the art at the time the invention was made that a user would have multiple accounts at the same banking institution because this simplifies transactions for the customer by reducing the overhead needed to process the transaction. The Examiner notes that it is common for consumers to have a checking and a savings account at the same bank.

As per claim 22,

Ito et al. ('250) discloses the method of claim 12,

Official Notice is taken that "transferring funds from the identified account to a different one of said plurality of accounts in response to a request from the first user" is common and well known in prior art in reference to electronic commerce. It would have been obvious to one having ordinary skill in the art at the time the invention was made to transfer funds from the identified account to a different one of said plurality of accounts in response to a request from the first user because this allows electronic commerce to occur.

As per claim 23,

Ito et al. ('250) discloses in a computer network, a computer system communicably coupled to a database of user accounts, the user accounts including values representing funds maintained by a financial institution on behalf of the users, the computer system executing code for updating the values in the user accounts, the code including instructions for:

automatically sending an electronic message to the second user using the electronic message address, the electronic message indicating that funds are ready for transfer to the second user; (Figure 2)

processing a response received from the second user to determine whether the second user has accepted or rejected the transfer of funds; and updating the values of the first user account and a second user account associated with the second user to reflect that the amount of funds was transferred from the first user to the second user if the response indicates acceptance. (Figure 2)

Ito et al. ('250) does not explicitly disclose "processing a transfer request received by the computer system from a first user over the network, the transfer request including an amount of funds for transfer from a first user account associated with the first user and identification information for a second user". Amos ('184) discloses "processing a transfer request received by the computer system from a first user over the network, the transfer request including an amount of funds for transfer from a first user account associated with the first user and identification information for a second user" (column 2, lines 44-52, also figure 2). It would be obvious to one of ordinary skill in the art at the time of the invention to combine the Ito et al method with Amos's teaching in order to allow the completion of a financial transaction while providing the convenience to the consumer of completing the transaction at a time outside normal banking hours via the Internet.

Art Unit: 3621

Ito et al discloses ... the identification information including an electronic message address for the second user;(Abstract)

Ito et al. ('250) does not explicitly disclose "opening a first online account in response to a request from a first user to open the first account, receiving credit card account information from the first user, establishing a connection with a server associated with the credit card account, transferring funds from the credit card account to the first account ". Brake, Jr et al. ('136) discloses "opening a first online account in response to a request from a first user to open the first account (Column 2, lines 51-58), receiving credit card account information from the first user,(Column 6, lines 5-26) establishing a connection with a server associated with the credit card account,(Column 6, lines 5-26) transferring funds from the credit card account to the first account (column 10, lines 11-18)". It would be obvious to one of ordinary skill in the art at the time of the invention to combine the Ito et al method with Brake, Jr et al. teaching in order to allow the consumer to manage credit accounts.

As per claim 28,

Ito et al. ('250) discloses the computer system of claim 23, wherein the transfer request further includes a request for identity confirmation, and wherein the response from the second user includes identity information responsive to the request for identity confirmation, the code further including instructions for:

automatically sending the identity information to the first user;(Column 5, lines 27-40)  
processing a second response received from the first user indicating acceptance or rejection of the identity information;(Column 5, lines 41-46, also figure 2)  
wherein the values are updated only if the second response indicates acceptance.(Figure 4)

As per claim 29,

Ito et al. ('250) discloses the computer system of claim 28,

Official Notice is taken that "the request for identity confirmation includes a query, and wherein the identity information from the second user includes an answer to the query" is common and well known in prior art in reference to electronic commerce. It would have been obvious to one having ordinary skill in the art at the time the invention was made that the request for identity confirmation includes a query, and the identity information from the second user includes an answer to the query because the usage of such a query would improve the security of the system by preventing unauthorized users from making transactions.

As per claim 30,

Ito et al. ('250) discloses in a computer network, a computer system communicably coupled to a database of user accounts, the user accounts including values representing funds maintained by a financial institution on behalf of the users, the computer system executing code for updating the values in the user accounts, the code including instructions for:

automatically sending an electronic message to the second user using the electronic message address, the electronic message including the amount of funds to be transferred to the first user; (Abstract)

processing a payment response received from the second to determine whether the second user has accepted or rejected the payment request;(Figure 4)



Art Unit: 3621

sending a second electronic message to the first user indicating whether the payment response from the recipient indicates acceptance or rejection of the payment request and if the payment response indicates acceptance: processing a transfer request received from the first user to determine a user account identified by the first user;(Figure 4)

updating the values of the identified account and a second user account associated with the second user to reflect that the amount of funds was transferred from the second user to the first user.(Figure 2)

Ito et al. ('250) does not explicitly disclose "processing a payment request received from a first user over the network, the payment request including an amount of funds for transfer to a first user account associated with the first user and identification information for a second user". Amos ('184) discloses "processing a payment request received from a first user over the network, the payment request including an amount of funds for transfer to a first user account associated with the first user and identification information for a second user", (column 2, lines 44-52, also figure 2). It would be obvious to one of ordinary skill in the art at the time of the invention to combine the Ito et al method with Amos's teaching in order to allow the completion of a financial transaction while providing the convenience to the consumer of completing the transaction at a time outside normal banking hours via the Internet.

Ito et al discloses ... the identification information including an electronic message address for the second user;(Abstract)

Ito et al. ('250) does not explicitly disclose "Wherein the payment response further includes a request to open an account for the payor, the method further including: opening the second account, depositing funds into the second account wherein depositing includes receiving credit card account information from the payor, establishing a connection with a server associated with the credit card account and transferring funds from the credit card account to the second account". Brake, Jr et al. ('136) discloses "Wherein the payment response further includes a request to open an account for the payor, the method further including: opening the second account,(Column 2, lines 51-58) depositing funds into the second account wherein depositing includes receiving credit card account information from the payor,(Column 6, lines 5-26) establishing a connection with a server associated with the credit card account (Column 6, lines 5-26) and transferring funds from the credit card account to the second account(column 10, lines 11-18)". It would be obvious to one of ordinary skill in the art at the time of the invention to combine the Ito et al method with Brake, Jr et al. teaching in order to allow the consumer to manage credit accounts.

As per claim 33,

Ito et al. ('250) discloses the computer system of claim 30, wherein if the payment response from the second user indicates acceptance of the payment request, the payment response further includes a request for identity confirmation, and wherein the transfer request from the first user includes identity information responsive to the request for identity confirmation, and wherein the code further includes instructions for:

automatically sending the identity information to the second user;(Column 5, lines 27-40)  
processing a second response received from the second user to determine whether the identity information was accepted or rejected;(Column 5, lines 41-46, also figure 2)  
wherein values are updated only if the identity information was accepted.(Figure 4)

Art Unit: 3621

Claims 4, 5, 26, 27 and 35 are rejected under 35 U.S.C. 103(a) as being anticipated by Ito et al. (US Patent 6,039,250) in view of Amos (US Patent 6,554,184) and further in view of Picciallo (US Patent 6,044,360).

As per claim 4,

Ito et al. ('250) discloses the method of claim 1,

Ito et al. ('250) does not explicitly disclose "the response includes a request by the recipient to open an account, and wherein the method further includes the step of opening the second account for the recipient". Picciallo ('360) discloses "the response includes a request by the recipient to open an account, and wherein the method further includes the step of opening the second account for the recipient", (column 10, lines 24-48). It would be obvious to one of ordinary skill in the art at the time of the invention to combine the Ito et al method with Picciallo's teaching in order to allow the senders to set spending limits on the recipients account by limiting the amount of money placed in the account.

As per claim 5,

Ito et al. ('250) discloses the method of claim 1,

Ito et al. ('250) does not explicitly disclose "the response from the recipient includes information identifying the second account". Picciallo ('360) discloses "the response from the recipient includes information identifying the second account", (column 9, lines 1-13). It would be obvious to one of ordinary skill in the art at the time of the invention to combine the Ito et al method with Picciallo's teaching in order to allow recipients account to be uniquely identified.

As per claim 26,

Ito et al. ('250) discloses the computer system of claim 23,

Ito et al. ('250) does not explicitly disclose "the response includes a request by the second user to open an account, and wherein the code further includes instructions for opening the second account for the second user". Picciallo ('360) discloses "the response includes a request by the second user to open an account, and wherein the code further includes instructions for opening the second account for the second user", (column 10, lines 24-48). It would be obvious to one of ordinary skill in the art at the time of the invention to combine the Ito et al method with Picciallo's teaching in order to allow the senders to set spending limits on the recipients account by limiting the amount of money placed in the account.

As per claim 27,

Ito et al. ('250) discloses the computer system of claim 23,

Ito et al. ('250) does not explicitly disclose "the response from the second user includes information identifying the second account". Picciallo ('360) discloses "the response from the second user includes information identifying the second account", (column 9, lines 1-13). It would be obvious to one of ordinary skill in the art at the time of the invention to combine the Ito et al method with Picciallo's teaching in order to allow recipients account to be uniquely identified.

Art Unit: 3621

As per claim 35,  
Ito et al. ('250) discloses the computer system of claim 30,  
Ito et al. ('250) does not explicitly disclose "the payment response from the second user includes information identifying the second account". Picciallo ('360) discloses "the payment response from the second user includes information identifying the second account", (column 9, lines 1-13). It would be obvious to one of ordinary skill in the art at the time of the invention to combine the Ito et al method with Picciallo's teaching in order to allow recipients account to be uniquely identified.

### *Allowable Subject Matter*

Claims 43-48 are allowed.

Claims 10 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### *Conclusion*

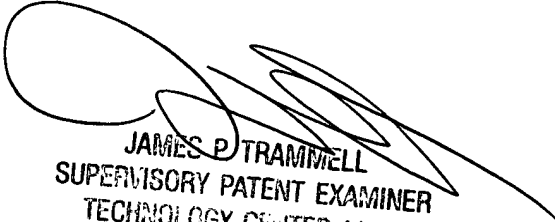
Examiners note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John M Winter whose telephone number is (703) 305-3971. The examiner can normally be reached on M-F 8:30-6, 1st Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P Trammell can be reached on (703)305-9768. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

JMW  
December 1, 2003



JAMES P. TRAMMELL  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3800